

REMARKS

Claims 22-42 are pending.

1. Applicant provisionally elects Group I, claims 23-34, with a Request For Reconsideration of the Requirement under 37 CFR 1.143.

The reasons for reconsideration are discussed below:

1. Group I + II are not related as "subcombinations disclosed as useable together in a single combination" (MPEP 806.05 (d)) as the restriction states. Instead, Group I + II are more properly stated to be process (II) and apparatus for its practice (I) (MPEP 806.05 (e)). Therefore, the reasoning of the restriction requirement is respectfully not correct. Also, Group I (A, B, C) and Group II (E, F) are each respectively subcombinations of what? There is no claim (A, B, C, E, F) for example. Thus, the restriction does not list any main combination that Group I and Group II would each be "subcombinations" of. Therefore, it is respectfully asserted that the reasoning of the restriction is not correct.

Additionally, Groups I and II pass the one-way distinctiveness test and do not require restriction (MPEP 806.05 (e)). Thus, applicants respectfully assert that the method and apparatus are interrelated and appropriately examined together.

2. Groups I and II are stated to require restriction because they are related as combination (I) and sub-combination (II).

Further, the particulars of the combination (II) with its claimed "curvature measurement" is stated to not be required for the combination.

In reference to MPEP 806.05 (c), it is noted that claim 22 (Group I) claims (A, B, C) while claim 39 (Group III) claims (A, B, C, D). Therefore, the claims are related by combination and subcombination.

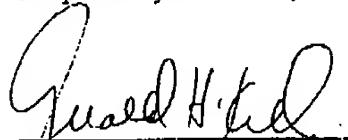
As preliminary matters, applicants assert that first, only claims 39-42 will be affected by a restriction and would be forced to be examined in a divisional application. This seems inconsistent with the goals of "compact prosecution" under the Patent Business Goals (PBG) rules, i.e., to file a separate application for only four claims, with only one independent claim, claim 39. Second, the search will be the same for method and apparatus. Third, it will be more efficient for the USPTO to examine the claims in the same application. Fourth, it will be less expensive for the applicant to avoid payment of separate prosecution fees, issues fees, and maintenance fees. Fifth, there is a general public policy against allowing separate patents to the same subject matter. Therefore, as a matter of public policy, and Patent Office policy, the restriction is not required. Lastly, a patentability report under MPEP 705 would probably indicate that the same Examining Group should handle the application and no restriction required.

As a final matter, claim 22 is genus, or generic and/or a linking claim to claim 39 and therefore claim 39 and Group III should be examined with Group I. (MPEP 808.01(a), 808.02, 809.02).

II. Conclusion

Therefore, applicant respectfully requests that the Examiner please reconsider and withdraw the election requirement.

Respectfully submitted,



Gerald H. Kiel  
Reg. No. 25,116  
Attorney for Applicant

Reed, Smith LLP  
375 Park Avenue, 17<sup>th</sup> Floor  
New York, New York 10152  
(212) 521.5449